

REMARKS

Claims 1-7, 10-17, 20-27, 30 and 40-76 are presented in this application. The Examiner, in the Official Action, rejected claims 1, 11, 21, 40 and 50 under 35 USC § 112 for the reasons set forth therein. With regard to the clarification as to how and when the high resolution digital image is transmitted after using the software, claims 1, 11 and 40 have been amended to set forth that the user transmits the high resolution image file to the service provider after using the software. Thus, it is believed that these claims have been clarified in this respect. Also with respect to claims 21 and 50, appropriate antecedent basis has been provided for said software.

With regard to the Examiner's objection as to how the "software" function and how it is used, Applicant respectfully submits that the claim is clear in this respect. The Examiner states that there is no explanation of how the software specifically relates to the manipulation of each image or what such manipulation comprises. The portion of the claims dealing with the providing of software deals with the fact that the server provided by the service provider has software thereon that allows manipulation and/or ordering of goods or services by the user. This simply means that the user can use a software that is located at the server for providing these functions. As set forth at page 8, lines 19-21, an advantage of using software located at the network service provider is that the network's photo service provider may have more sophisticated and up to date software. Further, at page 7, lines 12-17, the software provided at the service provider can perform various known image manipulations such as image sharpening, contrast, brightness adjustment, color balancing, tone scale adjustment. There is, of course, the zooming and cropping that is well known to all those skilled in the art. Thus, the manipulations just simply relates to what can be done to the digital images at the service provider site. Of course, the ordering of goods or services can also be done at the server provider. Thus, it is respectfully submitted that these claims are clear in this regard. In view of the foregoing, Applicant respectfully submits that the rejections under 35 USC § 112 have been overcome.

The Examiner has rejected claims 1-7, 11-17, 21-27 and 40-76 under 35 USC § 103(a) as being unpatentable over Hoekstra et al. US 6,304,277 for the reasons set forth therein.

Applicant would first like to address some of the responses to Applicant's responses to arguments presented by the Examiner. As Applicants have previously set forth, the present invention is directed to a method and system for ordering digital image goods and/or services by a user over a communication network. In particular, the goods and services to be provided are provided by the remote service provider. The remote service provider uses the high resolution digital image in providing the goods and/or services. Thus, the present invention is directed to providing goods or services to a user wherein the high resolution images must be uploaded to the service provider. In order to make the process more efficient for the user, low resolution images are first uploaded to the service provider whereby user actions are allowed for manipulating and ordering goods or services prior to receipt of the high resolution images. In addition, meta data is supplied with regard to the high resolution digital image that can assist the service provider in providing feedback to the user with regard to the applicability of the images with respect to certain goods or services that have been ordered or may be ordered. This allows the users to decide whether or not it is appropriate to continue further with the ordering of goods and/or services.

This is in contrast to the goals and purposes of the cited '277 reference which is primarily directed to the commercial photography segment. In particular, the '277 reference is directed to a system where images that originate at a first location are to be modified according to instructions provided by the originator by expert digital manipulation facility. In this regard as the Examiner set forth, low resolution images are sent from the creator's (originator) computer to a processor's computer via a network. With the low resolution image, the creator sends a job ticket which enumerates corrections and/or images desired. The Examiner tends to equate this ticket order with meta data. However, this is not the type of information to which Applicant's invention is directed. The meta data provided by Applicant deals with the image itself. As set forth at page 7, lines 4-17 of the present application, the meta data is used by the service provider to provide feedback that includes warnings that the image data available is insufficient for producing at an expected quality level the requested product or

service. As further set forth, the feedback may set forth that the image data available requires or would benefit from image enhancement or processing steps. This is in contrast to the '277 patent which is directed to ordering a service, i.e. the manipulation of image corrections so that they can be applied to a high resolution image back at the creator's location. The Examiner states that the service provider provides feedback to the user based on image file is inherent and comprises a negative message if the image is of sufficient quality for reproduction. In this regard the Examiner refers to column 2, line 55. This part of the passage of the '277 reference is simply directed to restoring the low resolution image to a working configuration for use by the computer. Before transmission, the images are compressed for faster transmission. However, it is still a low resolution image. Upon receipt of the compressed low resolution image, the image must be decompressed so that it can be worked upon by the processor. There is nothing to suggest that this provides information of insufficient quality for reproduction. The Examiner states at page 2, that the transmission of information relating to the image in general inherently comprises information regarding the original, high resolution image. However, there is nothing in the cited reference to support this statement. In this regard, Applicant refers the Examiner to *In re Lee* CAFC 277 Fed 3rd 1338 (61 USPQ 2nd 1430) 2002. The Court stated at page 1443:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness ... The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record ... Our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references ... there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.”

and at page 1434, the Court stated:

“only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”

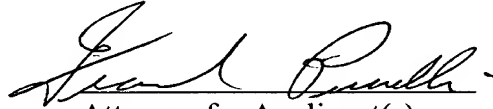
In this regard there is no motivation, teaching or suggestion of making the modification in Hoekstra et al. as suggested by the Examiner. In particular, there is no teaching or suggestion of providing meta data as taught and claimed by Applicant. Further, there is no teaching or suggestion of retransmitting the high resolution image from the originator to the service provider. Quite the contrary, Hoekstra teaches away in that only the low resolution image is sent to the digital processor. The Hoekstra reference is primarily directed to the commercial photographic arena, i.e. commercial photographers. In particular see column 1, lines 23-25 which sets forth that the origination sites may include “photo studios with a digital camera, design firms with desktop scanners, or photo labs having CD facilities. These three places are not the typical consumer photographer to which the present invention is directed. The problem solved by the present invention is not simply transmitting of images, but the ordering of goods or services wherein the high resolution image is used by the service provider to produce the goods or services. The Hoekstra reference is directed to the commercial photography arena wherein the originator will be using the images in some form. However, in the ‘277 reference they require some further professional image manipulation by an expert in the field. Thus, there is no motivation, teaching or suggestion to arrive at the method and or system taught and claimed by Applicant. The reference to column 1, line 30 merely is directed to the use of these commercial facilities for public use of the image. This is in contrast to a consumer type system to which the present invention is directed whereby consumers/users can order goods or services incorporating high resolution images provided by them. Thus, in the present situation, the high resolution must be transmitted as opposed to the Hoeksta reference where the high resolution image is never transmitted. Thus, the ‘277 patent and the present invention are directed to two totally different problems to two totally different solutions. Accordingly, Applicant respectfully submit that independent claims 1-7, 11-17, 21-27 and 40-76 are patentably distinct over the cited references for the above-reasons.

With regard to the rejection of claims 10, 20 and 30 under 35 USC § 103(a) as being unpatentable over Hoekstra et al. in view of Hopkins U.S. 6,282,462, Applicant respectfully submit that these claims are patentably distinct

for the same reasons previously discussed as these are dependent claims and depend at least ultimately on the independent claims previously discussed.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written over a horizontal line.

Attorney for Applicant(s)
Registration No. 27,370

Frank Pincelli/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646